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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/511,856	10/14/2004	Jonathan V. Caspar	CL1936USPCT	6354

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EXAMINER

SCHILLING, RICHARD L

ART UNIT PAPER NUMBER

1752

DATE MAILED: 03/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/511,856

Applicant(s)

CASPAR ET AL.

Examiner

Richard L. Schilling

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 January 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 14,17-23,25,26,28,30-36,38-40 and 43-52 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 14,17-23,25,26,28,30-36,38-40 and 43-52 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

1. Claims 36, 49, and 50 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 36 depends on itself. There is no singular antecedent basis for the term "the crosslinkable binder" in claims 49 and 50 since parent 14 has two crosslinkable binders.

2. Claims 40 and 43-46 rejected under 35 U.S.C. 102(e) as being fully met by Andrews et al. '614 for the same reasons as set forth in paragraph 3 of the first office action filed 9-29-05. The color filters claimed in instant claims are not materially different from those made in Andrews et al.(col. 11, lines 1-35) wherein the receiving layers function as planarizing layers. The declaration by Gerald Andrews does not mention U S patent 6,921,614.

3. Claims 30-36, 38, 40 and 43-46 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Guehler et al. Guehler et al. (see particularly col. 6, line 50-col. 8, line 21; col. 14, lines 14-34; col. 15, lines 3-40; col. 17, lines 41-59) discloses forming color filters by thermal transfer from donors of crosslinkable binders of prepolymers and oligomers. The color filter layers are covered by planarizing layers 16 as shown in figure 2. The oligomers or prepolymers of Guehler et al. would inherently have MW as required by the instant claims. Alternatively, it would at least be obvious to one skilled in the art to use oligomers as the crosslinkable binders in the donors of Guehler et al. since Guehler et al. discloses that oligomers, compared to higher MW polymers, reduce binder cohesive forces thereby improving imaging sensitivity and transferred image resolution. It would

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be obvious to one skilled in the art to adjust oligomer or prepolymer binder MW in Guehler et al. for improved sensitivity and resolution while still maintaining sufficient cohesive forces for binding or layer formation.

4. Claim 39 is rejected under 35 U.S.C. 103(a) as being unpatentable over Guehler et al. in view of EP 1,138,731. EP 1138731 (para. 3, 10-12) discloses crosslinkable protective films for color filters to reduce surface roughness or planarize the color filter layers with weight average MW of 5,000-200,000. It would be obvious to one skilled in the art to use the protective layers of EP 1138731 as the called for planarizing layers of Guehler et al.

5. Claim 39 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The intended MW is indefinite since the specification and claim 28 use weight average while claim 39 uses number average.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

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Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 14, 17-23, 25, 26, 28, 30-36, 38-40 and 43-52 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 7-34 of copending Application No. 10/511584 (see PG Pub. 2005/0238968). Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 7-34 of 10/511584 cover using crosslinkable binders for the donor and receiving layers specifically set forth in their specification (para. 13, 61, 77 of the PG Pub.) which have MW covered by the instant claims and claim 10 of 10/511854 sets forth the MW ranges required by the instant claims. Claims 7-34 of 10/511854 use planarizing elements as required by instant claims 28 and 39.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

7. Johnson and WO 01/96116 are cited of interest as disclosing planarizing layers for color filters.

Any inquiry concerning this communication should be directed to Richard L. Schilling at telephone number 571-272-1335.

RICHARD L. SCHILLING
PRIMARY EXAMINER
GROUP 1120-1752
